

REMARKS:

By this Amendment, claims 6-8, 10, 11, 16-18, 20, 46-48, 50-56, and 58-61 are amended and claims 4, 15, and 44 are cancelled, thereby leaving claims 49 and 57 unchanged. Claim 13 remains withdrawn.

The Examiner objects to the drawings because "drawing sheets are not numbered. It should be noted that each drawing sheet has to have a number in the middle of the top margin of the sheet." (Emphasis added by Applicant). Applicant respectfully disagrees with the Examiner's drawing objection. Reference is made to 37 C.F.R. 1.84 where the standards for drawings are set forth. More particularly, reference is made to 37 C.F.R. 1.84(t) entitled *Numbering of sheets of drawings* where said section recites "[t]he sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1,...these numbers, if present, must be placed in the middle of the top of the sheet..." (Emphasis added by Applicant). From these drawings standards, one can clearly ascertain that page numbering on drawings is optional and is in no way required as suggested by the Examiner. Applicant has prosecuted hundreds, if not thousands, of applications in the past, many of which did not include page numbering, and the drawings of such applications were never objected to for page numbering reasons. Accordingly, withdrawal of the drawing objection is respectfully requested.

Claims 44, 50-54, 56, and 57 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,382,334 ("Reynolds"). Claims 4, 6-8, 10, 15-18, 20, 44, 50-54, and 56-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over German Patent No. DE 298 15 937 ("Chen") in view of Reynolds. Claims 4, 7, 8, 10, 11, 17, 18, 20, 44, 46-49, 52-55, and 58-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of U.S. Patent No. 4,600,396 ("Crane") and further in view of Reynolds.

In the present Amendment, dependent claims 16, 17, 54, and 55 have been amended into independent form to include their respective base claim and any intervening claims. Dependent claims 16, 17, 54, and 55 have all been searched and examined by the Examiner in the current Office Action mailed April 11, 2007, which implies that the Examiner was able to sufficiently search the subject matter of all four claims in order to offer an opinion on the patentability of said claims. If the Examiner was not able to sufficiently search the subject matter of dependent claims 16, 17, 54, and 55, any issuance of a patentability opinion would be unsubstantiated and improper.

In the event the Examiner attempts to restrict the currently pending claims as being directed to independent or distinct inventions that would require additional or separate searches for appropriate consideration, Applicant respectfully submits that no serious burden will be placed on the Examiner for examining all of the pending claims in the present application. Specifically, the pending claims relate to subject matter that is so inextricably related to one another that the inventions should be examined in a single application. Applicant respectfully submits that a complete and thorough search of the prior art for one of the independent claims would require a search of the subject matter of the other independent claims.

Practicality, efficiency, and the lack of serious burden on the Examiner dictate that all the currently pending claims should be retained in the same application and a restriction requirement should be withheld.

The Examiner's own actions illustrate that no serious burden exists for the Examiner to consider all of the currently pending claims in the present application. More specifically, the fact that the Examiner has issued a patentability opinion on claims 16, 17, 54, and 55 illustrates that the Examiner was capable of searching the subject matter of all the pending claims in the same application.

Accordingly, a restriction requirement would be improper and conflict with the Examiner's previous actions.

35 U.S.C. §102(b) Rejections

Independent claim 54 recites:

A saw comprising:
a housing;
a motor at least partially positioned within the housing and operable to drive a saw blade;
a cover selectively connectable to the housing, the cover at least partially covering the saw blade when the cover is connected to the housing; and
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools, the quick-locking member being pivotable between a first position, in which the cover is locked to the housing, and a second position, in which the cover is not locked to the housing;
wherein the housing defines a handle portion gripable by a user, the quick-locking member being connected to the housing near the handle portion.

Reynolds does not teach or suggest, inter alia, a quick-locking member connected to a housing of the saw near a handle portion of the housing. Rather, Reynolds discloses a handle 16 and a locking mechanism 49 not positioned near the handle 16.

For this and other reasons, Reynolds does not teach or suggest the subject matter of independent claim 54. Accordingly, independent claim 54 should be allowed. Claims 50, 51, 53, 56, 57, and 60 depend from independent claim 54 and should be allowed for the same and other reasons as independent claim 54.

35 U.S.C. §103(a) Rejections

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. In re Vaack, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§706.02(j), 2143.03.

Independent claim 16 recites:

A circular saw comprising:
a housing;
a motor at least partially positioned within the housing and operable to drive a circular saw blade;
a shoe plate connected to the housing and engageable with a surface of a workpiece to support the circular saw upon the workpiece, the circular saw blade being disposed both above and below the shoe plate;
a cover selectively connectable to the housing, the cover at least partially covering the circular saw blade when the cover is connected to the housing; and

a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools;

wherein the quick-locking member is connected to the housing and is engageable with the cover;

wherein the quick-locking member has a first position, in which the quick-locking member engages the cover to lock the cover to the housing, and a second position, in which the quick-locking member is disengaged from the cover and the cover is not locked to the housing;

wherein the quick-locking member is pivotable between the first position and the second position;

wherein the quick-locking member includes a first member connected to the housing, a second member connected to the first member and pivotable relative to the first member, and a third member connected to the second member and pivotable relative to the second member, the third member being engageable with the cover to selectively lock the cover to the housing; and

wherein the third member is engageable by a user to move the third member into and out of engagement with the cover to lock and unlock, respectively, the cover from the housing.

In connection with independent claim 16, only the Examiner's deficiency to satisfy the third criteria required for establishing a *prima facie* case of obviousness will be address herein, even though deficiencies may exist for the first criteria and the second criteria.

Chen does not teach or suggest, *inter alia*, a quick-locking member pivotable between a first position and the second position (acknowledged by the Examiner on page 6 of Office Action mailed April 11, 2007), the quick-locking member including a first member connected to the housing, a second member connected to the first member and pivotable relative to the first member, and a third member connected to the second member and pivotable relative to the second member, the third member being engageable with the cover to selectively lock the cover to the housing, and the third member being engageable by a user to move the third member into and out of engagement with the cover to lock and unlock, respectively, the cover from the housing.

Reynolds does not cure the deficiencies of Chen. Reynolds does not teach or suggest, *inter alia*, a circular saw including a shoe plate connected to a housing of the circular saw and engageable with a surface of a workpiece to support the circular saw upon the workpiece, a circular saw blade being disposed both above and below the shoe plate, a cover at least partially covering the circular saw blade, and a quick-locking member including a third member engageable with the cover to selectively lock the cover to the housing and the third member

being engageable by a user to move the third member into and out of engagement with the cover to lock and unlock, respectively, the cover from the housing. Rather, Reynolds discloses a chain saw with a saw chain for cutting workpieces, and a locking member 49 including a handle 53 engageable by a user and a loop 57 separate from the handle 53 engageable with a hook member 59 on a cover 46.

For these and other reasons, the combination of Chen and Reynolds does not teach or suggest the subject matter of independent claim 16 and, therefore, does not satisfy the third criteria for establishing a *prima facie* case of obviousness. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and independent claim 16 should be allowed. Claims 6, 8, 10, 11, and 46-49 depend from independent claim 16 and should be allowed for the same and other reasons as independent claim 16.

Independent claim 17 recites:

A circular saw comprising:
a housing;
a motor at least partially positioned within the housing and operable to drive a circular saw blade;
a shoe plate connected to the housing and engageable with a surface of a workpiece to support the circular saw upon the workpiece, the circular saw blade being disposed both above and below the shoe plate;
a cover selectively connectable to the housing, the cover at least partially covering the circular saw blade when the cover is connected to the housing; and
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools;
wherein the quick-locking member is connected to the housing and is engageable with the cover;
wherein the quick-locking member has a first position, in which the quick-locking member engages the cover to lock the cover to the housing, and a second position, in which the quick-locking member is disengaged from the cover and the cover is not locked to the housing;
wherein the quick-locking member is pivotable between the first position and the second position; and
wherein the cover is a first cover, wherein the circular saw further comprises a second cover connected to the housing and disposed between the circular saw blade and the first cover when the first cover is connected to the housing, the second cover at least partially covering the circular saw blade when the first cover is both connected to and disconnected from the housing.

Regarding the Chen and Reynolds combination and independent claim 17, only the Examiner's deficiency to satisfy the third criteria required for establishing a *prima facie* case of obviousness will be addressed, even though deficiencies may exist for the first criteria and the second criteria.

Chen does not teach or suggest, *inter alia*, a first cover selectively connectable to a housing of a circular saw, a second cover connected to the housing and disposed between a circular saw blade and the first cover, and a quick-locking member pivotable between a first position and a second position (acknowledged by the Examiner on page 6 of Office Action mailed April 11, 2007). Rather, Chen discloses a first housing part 22, middle section 24 connected to the first housing part 22 with bolts 34, and a second housing part 26 connected to the middle section 24 with screw 42. In other words, both the middle section 24 and the second housing part 26 are not connected to the first housing part 22. Independent claim 17 recites that both the first cover and the second cover are connectable to the housing of the circular saw.

Reynolds does not cure the deficiencies of Chen. Reynolds does not teach or suggest, *inter alia*, a circular saw including a shoe plate connected to a housing and engageable with a surface of a workpiece to support the circular saw upon the workpiece, a circular saw blade disposed both above and below the shoe plate, a first cover at least partially covering the circular saw blade and selectively connectable to the housing of the circular saw, and a second cover connected to the housing and disposed between the circular saw blade and the first cover. Rather, Reynolds discloses a chain saw with a saw chain for cutting workpieces, and a single cover 46.

For these and other reasons, the combination of Chen and Reynolds does not teach or suggest the subject matter of independent claim 17 and does not satisfy the third criteria for establishing a *prima facie* case of obviousness. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness based on Chen and Reynolds, and independent claim 17 should be allowed. Claims 7, 18, and 20 depend from independent claim 17 and should be allowed for the same and other reasons as independent claim 17.

The combination of Chen, Crane, and Reynolds also fails to establish a *prima facie* case of obviousness. In connection with independent claim 17, only the Examiner's deficiency to satisfy the first criteria and third criteria required for establishing a *prima facie* case of obviousness will be address herein, even though deficiencies may exist for the second criteria.

Regarding the first criteria for establishing a *prima facie* case of obviousness, there is no suggestion or motivation, whether explicit or implicit, that the teachings of Crane should or could be combined with either Chen or Reynolds. The references are devoid of any teaching or suggestion of the claimed circular saw and any advantages that flow therefrom. The only motivation for the claimed circular saw comes from Applicant's invention, and, therefore, the Examiner's rejection based on Chen, Crane, and Reynolds is a classic case of hindsight.

The Examiner must find analogous art in order to rely on the art as a basis for rejection. To be analogous, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. Applicant respectfully submits that Crane is non-analogous prior art.

First, Crane is not in the Applicant's field of endeavor. Crane relates to the art of marine propulsion and discloses a cowl for a boat motor. Crane is clearly not related to saws.

Continuing, Crane is classified in a different PTO classification than Chen, Reynolds, and the Present Application. Crane is classified in class 440, subclass 77, related to marine propulsion and cowls for marine propulsion items. Chen has a variety of international classifications including B23D59/00; B23Q11/00; B27B9/00; B23D59/00; B23Q11/00; B27B9/00 generally relating to cutlery or cutting methods. Reynolds is classified in class 30, subclass 386, related to cutlery. The claimed invention of the Present Application has been preliminarily classified in class 30. The PTO classification of Crane is very different than the classifications of Chen, Reynolds, and the claimed invention of the Present Application, thereby accentuating that Crane is clearly not in the Applicant's field of endeavor. This difference in classification is sound reasoning for establishing non-analogous art and that Crane cannot be combined with Chen or Reynolds, since the USPTO commonly relies on the difference in classification to establish restriction requirements.

Second, Crane is not reasonably pertinent to the particular problem with which Applicant was concerned. A reference may be reasonably pertinent if it is one which logically would have commended itself to an inventor's attention in considering his problem. A person of ordinary skill in the art of saws would not reasonably be expected or motivated to look to the art of marine propulsion to solve the problems of saws. Applicant would have had less motivation or occasion to consider Crane because the reference is directed to a different purpose. The Examiner has combined the disparate elements from Chen, Crane, and Reynolds with the benefit of improper

hindsight, and the combination is insufficient to present a *prima facie* case of obviousness. For these and other reasons, Crane is non-analogous prior art and is not an appropriate basis for a rejection under 35 U.S.C. §103. Accordingly, the Examiner has failed to satisfy the requirements associated with the first criteria for establishing a *prima facie* case of obviousness.

Also, assuming *arguendo* that Chen, Crane, and Reynolds could or should be combined, the combination of Chen, Crane, and Reynolds fail to teach or suggest all the subject matter of independent claim 17 as is required by the third criteria for establishing a *prima facie* case of obviousness. Regarding Chen and Reynolds, reference is made to the remarks made above identifying the subject matter of independent claim 17 not taught or suggested by the combination of Chen and Reynolds. Crane does not cure the deficiencies of Chen and Reynolds. More particularly, Crane does not teach or suggest, inter alia, a circular saw including a motor operable to drive a circular saw blade, a shoe plate connected to a housing of the circular saw and engageable with a surface of a workpiece to support the circular saw upon the workpiece, the circular saw blade being disposed both above and below the shoe plate, a first cover at least partially covering the circular saw blade and a second cover connected to the housing and disposed between the circular saw blade and the first cover when the first cover is connected to the housing, the second cover at least partially covering the circular saw blade when the first cover is both connected to and disconnected from the housing, and a quick-locking member connected to one of a housing and a cover of a circular saw and engageable with the other of the housing and cover of the circular saw to selectively lock the cover of the circular saw to the housing of the circular saw without the use of tools, the quick-locking member having a first position, in which the quick-locking member engages the cover of the circular saw to lock the cover to the housing, and a second position, in which the quick-locking member is disengaged from the cover of the circular saw and the cover is not locked to the housing. Rather, Crane discloses an outboard motor including a latch for securing two portions of a cowl of the outboard motor. Accordingly, Crane fails to teach or suggest many of the claim limitations of independent claim 17.

For these and other reasons, Chen, Crane, and Reynolds do not teach or suggest the subject matter of independent claim 17 and do not satisfy at least the first criteria and third criteria for establishing a *prima facie* case of obviousness. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent claim 17 and independent claim 17

should be allowed. Claims 7, 18, and 20 depend from independent claim 17 and should be allowed for the same and other reasons as independent claim 17.

Independent claim 55 recites:

A saw comprising:
a housing;
a motor at least partially positioned within the housing and operable to drive a saw blade;
a cover selectively connectable to the housing, the cover at least partially covering the saw blade when the cover is connected to the housing;
a quick-locking member connected to one of the housing and the cover and engageable with the other of the housing and the cover to selectively lock the cover to the housing without the use of tools, the quick-locking member being pivotable between a first position, in which the cover is locked to the housing, and a second position, in which the cover is not locked to the housing; and
a second locking assembly cooperating with the quick-locking member to selectively lock the cover to the housing.

The combination of Chen, Crane, and Reynolds fails to establish a *prima facie* case of obviousness. In connection with independent claim 55, only the Examiner's deficiency to satisfy the first criteria and third criteria required for establishing a *prima facie* case of obviousness will be address herein, even though deficiencies may exist for the second criteria.

Regarding the first criteria for establishing a *prima facie* case of obviousness, there is no suggestion or motivation, whether explicit or implicit, that the teachings of Crane should or could be combined with either Chen or Reynolds. For the sake of brevity, reference is made to the pertinent remarks made above in connection with independent claim 17 to establish that the combination of Crane with Chen and Reynolds is improper.

Also, assuming *arguendo* that Chen, Crane, and Reynolds could or should be combined, the combination of Chen, Crane, and Reynolds fails to teach or suggest all the subject matter of independent claim 55 as is required by the third criteria for establishing a *prima facie* case of obviousness.

Regarding Chen, Chen does not teach or suggest, *inter alia*, a quick-locking member being pivotable between a first position, in which a cover is locked to a housing, and a second position, in which the cover is not locked to the housing (acknowledged by the Examiner on

page 6 of Office Action mailed April 11, 2007) and a second locking assembly cooperating with the quick-locking member to selectively lock the cover to the housing.

Regarding Reynolds, Reynolds does not teach or suggest, *inter alia*, a second locking assembly cooperating with a quick-locking member to selectively lock the cover to the housing. Reynolds only discloses a single locking mechanism 49.

Regarding Crane, Crane does not teach or suggest, *inter alia*, a saw including a motor operable to drive a saw blade, a cover at least partially covering the saw blade, and a second locking assembly cooperating with a quick-locking member to selectively lock the cover to the housing of the saw. Rather, Crane discloses an outboard motor including a single latch for securing two portions of a cowl of the outboard motor. On page 10 of the Office Action mailed April 11, 2007, the Examiner attempts to arbitrarily select portions of the single latch 14 to represent two items, namely a quick-locking member and a second locking assembly, in an attempt to satisfy the limitations of independent claim 55. This is clearly improper because the Examiner is attempting to interpret Crane in a manner contrary to the teachings of Crane. More particularly, reference is made to column 2, lines 27-45 where a latch assembly 14 is defined and the latch lever 19 is defined as a component of the latch assembly 14, thereby providing only a single latch 14. Accordingly, Crane fails to teach or suggest many of the claim limitations of independent claim 55.

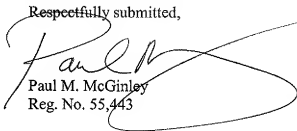
For these and other reasons, Chen, Crane, and Reynolds do not teach or suggest the subject matter of independent claim 55 and do not satisfy at least the first criteria and third criteria for establishing a *prima facie* case of obviousness. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent claim 55 and independent claim 55 should be allowed. Claims 52, 58, 59, and 61 depend from independent claim 55 and should be allowed for the same and other reasons as independent claim 55.

CONCLUSION:

In view of the foregoing, entry of the present Amendment and allowance of the pending claims are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,



Paul M. McGinley
Reg. No. 55,443

Docket No. 066042-9415-01
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
(312) 222-0800